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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,163	12/01/2003	Gottfried von Bismarck	31653-198560	9376
26694	7590	06/29/2004	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			TRAN, LOUIS B	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/724,163

Applicant(s)

VON BISMARCK, GOTTFRIED

Examiner

Louis B Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/01/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/01/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7-19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 7 recites the limitation "at least one identifying indicium" in line 3 of the claim but subsequently refers to a "the at least one indicium" in line 5 of the claim and "identifying indicium" in line 6 of the claim. It is unclear if the at least one indicium is the same as an identifying indicium.

Claim 19 requires "depriving the one commodity of at least one criterion". It is unclear what "the criterion" refers to and the scope the claim is indefinite. It is further unclear how a criterion can be deprived from something else.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boriani (6,209,290) in view of Evers et al. (EP 0542449 A1).

Boriani discloses the invention substantially as claimed including associating at least one commodity 9 with at least one identifying indicium 18, monitoring the at least one indicium 18 to gather information denoting the detected identifying indicium.

Boriani does not explicitly show confining the thus identified at least one commodity in a container and encoding the gathered information and applying the encoded information to the container.

However, Evers et al. teaches the use of confining a commodity 34 in a container 30 (as seen in Figure 2) and applying to the container at least one decodable symbol 42 which is indicative of the encoded at least one signal (as seen in Figure 9) for the purposes of indicating the type of product for sale as in column 8, lines 20-50.

Therefore, it would have been obvious to one having ordinary skill in the art to provide Boriani with the step of applying a decodable symbol in order to facilitate decoding the product for sales purposes.

With respect to claim 8, Evers shows wherein said monitoring step is carried out subsequent to said confining step and said at least one indicium is detectable through the container as in column 8, lines 15-40.

With respect to claim 9, Evers shows contents of the container consisting of an array of smokers' products, associating step including providing smokers' products with portion of a composite encoded information.

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With respect to claim 10, Boriani shows the associating step includes proving the commodity with a pattern of randomly distributed portions of a composite indicium seen in Figure 11.

With respect to claim 11, Boriani in view of Evers shows wherein said monitoring step is carried out prior to confining step.

With respect to claim 12, Boriani in view of Evers shows wherein the monitoring step includes ascertaining at least one of the position or characteristics of the one indicium as in column 6, line 33.

With respect to claim 13, Boriani in view of Evers shows the steps of decoding the applied information and comparing the decoded information with the information obtained as a result of said monitoring step.

With respect to claim 14, Boriani shows wherein said monitoring step includes ascertaining the position of the at least one indicium as in column 6, lines 26-33.

With respect to claim 15, Boriani in view of Evers shows wherein said monitoring step includes generating a plurality of first signals and further comprising the step of generating a second signal denoting the sum of said first signals, said encoding step including encoding said second signal as would be inherent in the combination of Boriani in view of Evers.

With respect to claim 16, Boriani shows wherein said associating step includes associating the at least one commodity with an indicium which is detectable through the container by at least one of acoustic, electrical, magnetic, electromagnetic, high-frequency, microwave and X-ray detectors.

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With respect to claim 17, Boriani shows wherein said associating step includes providing the at least one commodity with at least one internal identifying indicium as in Figure 1.

With respect to claim 18, Boriani shows wherein said associating step includes providing the at least one commodity with at least one external identifying indicium as in Figure 3.

With respect to claim 19, Boriani shows wherein the at least one commodity exhibits at least one criterion and said associating step includes depriving the at least one commodity of said at least one criterion.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

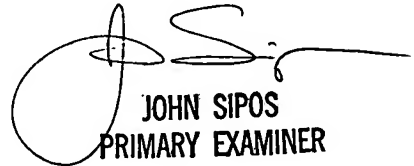
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis B Tran whose telephone number is 703-305-0611. The examiner can normally be reached on 8AM-6PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lbt



JOHN SIPOS  
PRIMARY EXAMINER